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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/868,785	10/16/2001	Judith Reinhard	Q65015	6194

7590 04/10/2003

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2100 Pennsylvania Avenue NW
Washington, DC 20037-3213

EXAMINER

PAK, JOHN D

ART UNIT	PAPER NUMBER
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1616

DATE MAILED: 04/10/2003

6

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/868,785

Applicant(s)

REINHARD ET AL.

Examiner

JOHN D PAK

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-67 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-67 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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Claims 1-67 are pending in this application.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rules 13.1, 13.2 and 37 CFR 1.475.

Group I, claims 1-8, 22-34, 35, 37, 39, 41, 43, 45, 47-54, directed to composition and method wherein a termite feeding stimulant-capable compound is used that has at least two OR groups, each OR attached to an aryl moiety, and at least one of R is a carbohydrate moiety (example: β -arbutin).

Group II, claims 1-5, 8-18, 22-34, 35-51, 54-64, directed to composition and method wherein a termite feeding stimulant-capable compound is used that has the formula I set forth in claim 9, for example.

Group III, claims 1-5, 8, 18, 22-34, 35, 37, 39, 41, 43, 45, 47-51, 54, 64, directed to composition and method wherein a termite feeding stimulant-capable compound is used that has a catechol type structure, as claimed (i.e. contains benzopyran moiety, for example, Registry Number 154-23-4).

Group IV, claims 1-5, 8, 18, 22-34, 35, 37, 39, 41, 43, 45, 47-51, 54, 64, directed to composition and method wherein a termite feeding stimulant-capable compound is used that is an addition compound such as quinhydrone structure, as claimed (i.e. contains a cyclohexadiene-1,4-dione structure).

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Group V, claims 1-5, 8, 19-34, 35, 37, 39, 41, 43, 45, 47-51, 54, 65-67, directed to composition and method wherein a termite feeding stimulant-capable compound is used that has a polyphenylether structure, as claimed.

Group VI, claims 1-5, 8, 22-34, 35, 37, 39, 41, 43, 45, 47-51, 54, directed to composition and method wherein a termite feeding stimulant-capable compound is used that has at least two OR groups, each OR attached to an aryl moiety, and said compound is *not* encompassed by Groups I, II, III, IV or V.

The compounds of the present invention are recited in Markush form. When the Markush grouping is for alternatives of chemical compounds, they shall be regarded as being of a similar nature where the following criteria are fulfilled:

(A) All alternatives have a common property or activity; **and**

(B)(1) A common structure is present, i.e. a significant structural element is shared by all of the alternatives; or

(C)(2) In cases where the common structure cannot be the unifying criteria, all alternatives belong to a recognized class of chemical compounds in the art to which the invention pertains.

In the present case, neither conditions (B)(1) nor (C)(2) are met.

Discussion of (B)(1): In compounds such as β -arbutin and catechol, to cite one example, the two OR groups are far from being significant structural elements. In β -arbutin, there is a glucopyranoside structure that is by far the most significant structural moiety and in catechol,

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benazopyran structure is by far the most significant structural element. The commonly shared structure does not constitute a structurally distinctive portion. With so many significant structural moieties that are possible from applicant's description of inventive compounds, it must be determined that there is not a common structure present, i.e. the shared common element is not sufficient vis-a-vis the rest of the divergent chemical structure for most of the compounds encompassed by the claim language.

Discussion of (C)(2): All alternatives here do not belong to a recognized class of chemical compounds in the art to which the invention pertains. β -arbutin has a carbohydrate moiety, catechol has a benzopyran moiety, 4-methoxy phenol is a simple alcohol with a methoxy substitution, etc. There is no recognized class of chemical compounds that would embrace all such structurally divergent compounds. A priori, there would appear to be no expectation from the knowledge in the art that all of the divergent compounds in the claims would behave in the same way in the context of the claimed invention.

Therefore, the claims in this application are not so linked as to form a single general inventive concept. There is not a technical relationship among the inventions involving the same or corresponding special technical feature. See MPEP 1850, Part D.

For these reasons, the lack of unity determination must be made.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

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Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

A facsimile center has been established in Technology Center 1600. The hours of operation are Monday through Friday, 8:45 AM to 4:45 PM. The telecopier numbers for accessing the facsimile machines are (703) 308-4556 or (703) 305-3592.

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Examiner Pak whose telephone number is (703) 308-4538. The Examiner can normally be reached on Monday through Friday from 7:30 AM to 4 PM.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's Supervisor, Mr. José Dees, can be reached on (703) 308-4628.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-1235.


JOHN PAK
PRIMARY EXAMINER
GROUP 1600